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**Application Number 10/779,406**  
Filing Date 02/17/2004  
Confirmation No. 7766  
Examiner: Collado, Cynthia Francisca  
**Art Unit 3618**  
**Office Action, date mailed 07/12/2005**

This is my reply to the Office Action.

If here reference is made to certain lines of the printed text, this refers to the print of the marked-up version of the text.

Para. 1

Item 1 ("the frame"): The claim is reworded, now listing the components of the rolling device including the frame, see p. 5 line 5

Item 2 ("the plane"): The claim is reworded. The concept of the "plane" is now abandoned. Instead, the angle beta is introduced in an equivalent meaning by mentioning "the vertical projection ... onto the ground", see p. 5 lines 23-26. The "ground" antecedes in line 3.

Item 3 ("closed fourfold linked chain"): I agree to your suggested replacement with "closed fourbar linkage". Thank you for your suggestion.

Item 4 ("or the like"): deleted (p. 5 line 21).

Para. 2, Double Patenting, improper timewise extension

In my recent application No. 10/779,406, I claim an angle between the *vertical projections* of two certain axes to be an acute angle, whereas US 6,755,425 *generally* claims an acute angle. The steering capability is attributed to the *horizontal-lateral projection* of this angle only (see Fig. 4 in US 6,755,425, or see Fig. 1 in 10/779,406, marked as "state of the art"). Therefore 10/779,406 is expressively *not* related to the mere steering capability of the skate, instead it addresses the issue of asymmetrically steering, if there is steering. This means, when US 6,755,425 expires, the recent application No. 10/779,406, if patented, does *not* give the right to exclude marketing of that type of steering skates which is described in US

6,755,425 (as this patent does not require the vertically projected angle beta to be larger than zero).

When US 6,755,425 expires, everybody has right to market steering skates of this type, provided that it is not made to steer asymmetrically using the claimed feature of 10/779,406, i.e. the angle beta. The angle alpha is then allowed for use.

In specifying the angle beta, I needed to repeat some wording of claim 1 of the US patent, so that any term used has its antecedent. I understand that using the angle beta greater than zero in a product as described in the claim is subject to 10/779,406. I understand also that using the angle alpha greater than zero *and* using the angle beta equaling zero in a product as described in the claim is subject to US 6,755,425 and not subject to 10/779,406 as the latter doesn't apply.

Hence, the recent application 10/779,406, if patented, does not extend the time of right to exclude with regard to US 6,755,425.

### Para. 3, Double Patenting, patentable distinctness

If angle beta as disclosed in application No. 10/779,406 were equal zero or very close to zero, than the asymmetry of the steering vanishes, which means that the purpose of the invention is not achieved. There still could be an angle alpha as described in US 6,755,425 which causes the steering, but, if beta is zero the steering is symmetric. Therefore beta and alpha are not inherently the same, irrespective of whether beta is zero or not.

The specification of 10/779,406, by stating the relationship of beta with regard to the non-zero parameters (see old print, page 5 line 4, "The angle ..."), implies that beta is never zero if the system is meant to function as intended.

I believed that requiring an "acute angle" semantically implies that this angle is not zero. As this is not to be assumed, I changed the wording of the claim, adding "...beyond zero...", see line 24, in order to clarify this issue.

As there is a definite geometrical-mathematical function for the angle beta dependent only on the angle alpha, on the desired difference in turn radius left versus turn radius right, and on the wheel base (i.e. the longitudinal distance of the front and rear wheels), any very small angle beta approaching zero does not make sense and can not be taken as an argument to enforce the "right to exclude".

US 6,755,425 claims the angle alpha to extend between two certain axes. This literally covers acute angles in both projecting directions, horizontal-laterally (alpha), and vertically (beta). Although the description and the purpose of the invention of US 6,755,425 only dealt with the horizontal-lateral projection, which reveals alpha, see Fig. 4, an acute angle in the vertical projection was not excluded by the claim 1. However, any such angle beta did not make sense within the scope of US 6,755,425. Taking the new purpose of asymmetrical steering in consideration, it would be very remote to assume from US 6,755,425, that the acute angle beta of the vertical projection, which was without any meaning until then, was the solution to this new problem.

It could be formally argued that Claim 1 in the US patent already fully covers the invention now claimed in the new application. But this is not true, as the claim 1 in US 6,755,425 did not distinguish between the two possibilities of the vertical projection of this angle to be zero and non-zero. This made it necessary to write a different specification, as was done with 10/779,406.

The two purposes of the two inventions are very distinct one from the other. The one provides the steering capability with no regard to the side of steering whether to the right or to the left. But it ignores the problem of the different radius required for the two legs of the skater. The second addresses just this problem anticipating that the steering problem is already solved. The solution to the first problem (US 6,755,425) is a prerequisite to the solution of the second problem but the solution of the first problem (angle alpha) is by far not sufficient to solve the second problem too. In particular, it ignores the crucial component of the angle between certain axes, i.e. its vertical projection. In other words, as the first solution does not make any difference between this vertical projection angle beta being zero or not, which means that it does not care for the difference of steering at right or at left, it does not provide the solution to the second problem. Therefore the solution to the asymmetric steering requirement needed to be specified anew.

By the way it is a great inventive idea to find out that the two very different problems have solutions which fit very nicely from the standpoints of design and cost.

In consequence both were distinct, the purposes/problems and the solutions. Hence, the application 10/779,406 is patentably distinct.

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If the Office continues to require a terminal disclaimer in compliance with 37 CFR 1.321(c) I will provide it. Please advise.

Should you still have questions or is my reply un-sufficient in some respect, please advise. To shorten the procedure, you may use email.

Best regards,

  
Wolfram Gorisch

Attachment: Marked-up and clean prints of the specification and claim, as revised according to the Office Action. No drawings.